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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,398	05/29/2001	Michael Patrick Connors	0015-013	7479

7590

05/21/2003

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EXAMINER

NI, SUHAN

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 05/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/870,398

Applicant(s)

CONNORS ET AL.

Examiner

Suhan Ni

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.                      6) ☐ Other: \_\_\_\_\_.

Regarding claim 4 and 21-22, Chi-Lin further discloses the communication earpiece, wherein the flexible connector is an electrical cable (10) as claimed.

Regarding claims 5-8 and 19-20, Chi-Lin further discloses the communication earpiece, wherein a connector cable (10) for electrically connecting the earpiece to a personal communications device (0022 of page 2).

Regarding claims 10-15, Chi-Lin further discloses the communication earpiece, wherein the earpiece is capable of providing a two-way communication (0022 of page 2) as claimed.

Regarding claim 25, Chi-Lin further discloses the communication earpiece, wherein the ear hook is a full ear hook as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 16-17 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chi-Lin (US-2002/0080989)

Regarding claim 9, Chi-Lin does not clearly teach a wireless device as claimed. Since providing a local wireless communication between earpiece and base piece is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a local wireless communication between earpiece and base piece for making the earpiece more desirable for the user, such as more mobility and less restraining.

Regarding claims 16-17, Chi-Lin does not clearly teach the details of the ear bud as claimed. Since providing an ear bud or earphone for partially blocking the ear canal of the user is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide an ear bud or earphone for partially blocking the ear canal of the user for the earpiece as an alternate choice, in order to allow the user to hear more than one sound sources, such as the incoming acoustic signal and the surrounding sound at the same time.

Regarding claims 23-24, Chi-Lin does not clearly teach a connector in a distal end of the connecting cable as claimed. Since providing a connector at a distal end of a cable of an earpiece is very well known in the art, it therefore would have been obvious to one skilled in the art at the time the invention was made to provide a suitable connector at the distal end of the connecting cable of the earpiece, in order to utilizing the earpiece for establish a communication with a transmitter/receiver.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Suhan Ni** whose telephone number is **(703)-308-9322**, and the number for fax machine is **(703)-305-9508**. The examiner can normally be reached on Monday through Thursday from 9:00 am to 7:30 pm. If it is necessary, the examiner's supervisor, **Curtis Kuntz**, can be reached at **(703) 305-4708**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900.

Suhan Ni

05/16/2003

A handwritten signature in black ink, appearing to read 'Suhan Ni', is written over a faint, dotted rectangular stamp.

**DETAILED ACTION**

1. This communication is responsive to the application filed 05/29/2001.

***Claim Objections***

2. Claim 18 is objected to because of the following informalities:

In line 3, "an ear bud for placing near **and** ear canal ..."

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 10-15, 18-22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Chi-Lin (US-2002/0080989).

Regarding claims 1 and 18, Chi-Lin discloses a communication earpiece (Fig. 4), comprising: an ear hook (1); an ear bud (2); and a flexible connector (13 and 20) for connecting the ear bud to the ear hook as claimed.

Regarding claims 2-3, Chi-Lin further discloses the communication earpiece, wherein the ear hook contains a microphone (11) and the ear bud contains a speaker (2) as claimed.